

REMARKS

By this amendment, claims 1, 8 and 10 have been amended. Claim 3 was previously canceled. Claims 1, 2 and 4-10 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the Final Action, and allowance of the application is respectfully requested.

Rejection under 35 U.S.C. §112

Claim 10 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In connection with this rejection and the comments in the office action on page 2, paragraph 2, the undersigned believes that the Examiner meant to state "A record carrier in the form of a computer-readable medium" is not described in the specification.

Applicant respectfully traverses this rejection for at least the following reason. As is presented herein, claim 10 is now more clearly directed to a record carrier in the form of a record medium of information for playback via a playback device. Support for the amendment to claim 10 can be found in the specification, as originally filed, in at least the Abstract; on page 1, lines 1-5; and on page 2, lines 20-25. Accordingly, the subject matter of claim 10 is described in the specification in such a way as to reasonably convey ... that the inventors, at the time the application was filed, had possession of the claimed invention. Withdrawal of the rejection is requested.

Rejection under 35 U.S.C. §103

Claim 1

Claim 1 recites an apparatus for recording a main multiplex stream file, comprising a main information signal of a video information signal and a first auxiliary information signal, and auxiliary elementary stream files, comprising further auxiliary information signals, in a track on a record carrier, so as to enable simultaneous presentation of the main information signal and at least one of the further auxiliary information signals, said track comprising a series of physical locations, said apparatus comprising:

first receiving means for receiving said main multiplex stream file;

second receiving means for receiving said auxiliary elementary stream files, wherein said auxiliary elementary stream includes (i) a first type of additional elementary streams, wherein a first type additional elementary stream file has a buffer leak bit rate and (ii) a second type of additional elementary streams, wherein a second type additional elementary stream file has a buffer leak bit rate that is less than the buffer leak bit rate of the first type additional elementary stream file;

first processing means for subdividing the main multiplex stream file into a sequence of main blocks having a main block size, wherein the main multiplex stream file has a buffer leak bit rate that is greater than the buffer leak bit rate of the first type additional elementary stream file, each main block comprising a part of the main information signal having a specific presentation time;

second processing means for subdividing each auxiliary elementary stream file into a sequence of auxiliary blocks per type, the auxiliary blocks each having a same auxiliary block size, the auxiliary block size being greater than the main block size, each auxiliary block comprising a part of a further auxiliary information signal having a specific presentation time; and

writing means for interleaved writing in said track of the record carrier, (i) in an initial physical location, at least one block of the second type of auxiliary elementary stream file comprising a part of at least one second type further auxiliary information signal having a specific presentation time, (ii) in a first physical location adjacent the initial physical location, at least one block of the first type of auxiliary elementary stream file comprising a part of at least one first type further auxiliary information signal having said specific presentation time,

(iii) in a second physical location, a subsequent block of the corresponding first type of auxiliary elementary stream file, and (iv) in at least one location between the first and second physical locations, at least one block of the main multiplex stream file comprising a part of the main information signal having a presentation time corresponding to the presentation time of the at least one block of the first type further auxiliary information signal to be written in the first physical location, wherein said writing means is further configured:

(v)(i) for repetitively writing subsequent parts of the main multiplex stream and parts of the corresponding first type of auxiliary elementary stream file contiguously in said track, and

(v)(ii) for writing a subsequent part of the second type of auxiliary elementary stream file at another physical location such that the part of the main multiplex stream file stored in a location preceding the location of the subsequent part of the second type of auxiliary elementary stream file has a presentation time that lies in a presentation time interval of a preceding part of the second type of auxiliary elementary stream file stored in said track, and the part of the main multiplex stream file, stored in a location subsequent said another physical location has a presentation time that lies in the presentation time interval of the part of the further second type of auxiliary elementary stream file stored in a current location of said track.

Support for the amendments to claim 1 (as well as for amendments to claims 8 and 10) can be found in the specification on at least page 5, lines 27-30; page 6, lines 14-32; page 10, lines 1-12, 20-23 and 24-34; page 11, lines 1-10 and 20-25; page 12, lines 5-10; and FIG. 4.

Claims 1, 2 and 4-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (EP Pat. No 0831647; hereinafter referred to as **Yamauchi**) in view of Kaneshige et al. (US Pat. No. 5,913,010; hereinafter referred to as **Kaneshige**).

With respect to claim 1, as amended herein, Applicant respectfully traverses this

rejection on the grounds that the references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Yamauchi** and **Kaneshige** references cannot be applied to reject claim 1 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Yamauchi** nor **Kaneshige** teach "writing means for interleaved writing ...

(i) *in an initial physical location*, at least one block of the *second type* of auxiliary elementary stream file ... having a specific presentation time,

(ii) *in a first physical location* adjacent the initial physical location, at least one block of the *first type* of auxiliary elementary stream file ... having said specific presentation time,

(iii) *in a second physical location*, a subsequent block of the corresponding *first type* of auxiliary elementary stream file, and

(iv) in at least one location between the first and second physical locations, at least one block of the *main multiplex stream file* ... having a presentation time corresponding to the presentation time of the at least one block of the *first type* ... to be written in the first physical location ... further configured:

(v)(a) for *repetitively writing* subsequent parts of the *main multiplex stream* and parts of the corresponding *first type* of auxiliary elementary stream file *contiguously* in said track, and

(v)(b) for *writing a subsequent part* of the *second type* of auxiliary elementary stream file *at another physical location* such that the part of the *main multiplex stream file* stored in a location preceding the location of the *subsequent part* of the *second type* of auxiliary elementary stream file has a presentation time that lies in a presentation time interval of a *preceding part* of the *second type* of auxiliary elementary stream file stored in said track, and the part of the *main multiplex stream file*, stored in a location subsequent said *another physical location* has a presentation time that lies in the presentation time interval of the *subsequent part* of the *second type* of auxiliary elementary stream file stored in a current location of said track" [emphasis added] as is now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Yamauchi** and **Kaneshige** references cannot be applied to reject claim 1 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Yamauchi** nor **Kaneshige** teaches, or even suggests, the desirability of the combination since neither teaches the specific "*writing means for interleaved writing ... (i) in an initial physical location, at least one block of the second type of auxiliary elementary stream file ... having a specific presentation time, (ii) in a first physical location adjacent the initial physical location, at least one block of the first type of auxiliary elementary stream file ... having said specific presentation time, (iii) in a second physical location, a subsequent block of the corresponding first type of auxiliary elementary stream file, and (iv) in at least one location between the first and second physical locations, at least one block of the main multiplex stream file ... having a presentation time corresponding to the presentation time of the at least one block of the first type ... to be written in the first physical location ... further configured: (v)(a) for repetitively writing subsequent parts of the main multiplex stream and parts of the corresponding first type of auxiliary elementary stream file contiguously in said track, and (v)(b) for writing a subsequent part of the second type of auxiliary elementary stream file at another physical location such that the part of the main multiplex stream file stored in a location preceding the location of the subsequent part of the second type of auxiliary elementary stream file has a presentation time that lies in a presentation*

time interval of a preceding part of the second type of auxiliary elementary stream file stored in said track, and the part of the main multiplex stream file, stored in a location subsequent said another physical location has a presentation time that lies in the presentation time interval of the subsequent part of the second type of auxiliary elementary stream file stored in a current location of said track” as specified above and as claimed in claim 1.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 2 and 4-7 depend from and further limit independent claim 1 and therefore are allowable as well.

As presented herein, claim 8 has been amended in a similar manner with respect to the amendments to claim 1. Accordingly, the rejection of claim 8 is traversed for at least the same reasons presented herein above with respect to overcoming the rejection of claim 1. Thus claim 8 is also believed allowable and an early formal notice thereof is requested. Claim 9 depends from and further limits independent claim 8 and therefore is allowable as well.

As presented herein, claim 10 has been amended in a similar manner with respect to the amendments to claim 1. Accordingly, the rejection of claim 10 is traversed for at least the same reasons presented herein above with respect to overcoming the rejection of claim 1. Thus claim 10 is also believed allowable and an early formal notice thereof is requested.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 8 and 10 are in condition for allowance. Claims 2 and 4-7 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 9 depends from and further limits independent claim 8 and therefore is allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. Withdrawal of the Final Action and an early formal notice of allowance of claims 1, 2 and 4-10 is requested.

Respectfully submitted,

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a-32658.259